

REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed November 2, 2006.

Claims 1-49 were pending in the Application prior to the outstanding Office Action. Claims 29-49 were previously withdrawn from consideration. In the Office Action, the Examiner rejected claims 1-19 and allowed claims 20-28. Applicants amend claims 1-3, 5-7, and 9-12, delete claims 8 and 29-49, and add claims 50 and 51. Applicants respectfully request reconsideration of the rejections.

**I. REJECTION UNDER 35 U.S.C. §103(A) OVER *SANTILLI* (US PAT. 6,364,883) IN VIEW OF *DUFF* (US PAT. 4,611,582) AND *ZUCHERMAN ET AL.* (US PAT. 6,364,883)
*Claims 1-4, 6-9, 12-14, and 18***

The Examiner rejected claims 1-4, 6-9, 12-14 and 18 under 35 U.S.C. §103(a) as being unpatentable over *Santilli* in view of *Duff* and *Zucherman*. Applicants respectfully traverse the rejection of claims 1-4, 6, 7, 9, 12-14 and 18.

In the Office Action, the Examiner writes that *Duff* discloses “adjustable grips for the spinous processes (2) that can adjust relative to securing the vertebrae.” See OA, page 3. However, nowhere does *Duff* teach or suggest grips “adapted to frictionally contact opposite sides of one of the adjacent spinous process” as recited in claims 1 and 12.

In addition to the plate and the grips, the present embodiment of the invention includes a “spacer rotatably mounted between the first and second plates.” The rotatable spacer assists in positioning this embodiment between the spinous processes and spreads the load that the spinous processes can place on the spacer. The spacer is separate and not part of the first grip and the second grip. In one embodiment the spacer is rotatably mounted on a pin which extends between the first and second plates.

Because *Santilli* in view of *Duff* and *Zucherman* fails to teach or suggest all of the features of claims 1 and 12, *Santilli* in view of *Duff* and *Zucherman* cannot render claims 1 and 12 obvious under 35 U.S.C. §103(a). Dependent claims have at least the features of the independent claims from which they depend. Therefore, *Santilli* in view of *Duff* and *Zucherman* cannot render claims 2-4, 6, 7, and 9 (which ultimately depend from claim 1) and claims 13, 14 and 18 (which depend from claim 12) obvious under 35 U.S.C. §103(a).

**II. REJECTION UNDER 35 U.S.C. §103(A) OVER *SANTILLI* IN VIEW OF *DUFF* AND *ZUCHERMAN ET AL.* AND FURTHER IN VIEW OF *MATHEWS* (US PAT. 5,171,279)
*Claims 10, 11, 15 and 16***

The Examiner rejected claims 10, 11, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Santilli* in view of *Duff* and *Zucherman* and further in view of *Mathews*. Applicants respectfully traverse the rejection.

In the Office Action, the Examiner writes that “claims 10-11, and 15-16 are rejected...over the combination of Santilli ‘883, Duff ‘582 and Zucherman et al. ‘039 as applied to claim 9 above, and further in view of Mathews” See OA, page 3. For the reasons given above in Section I, *Santilli* in view of *Duff* and *Zucherman* fails to teach or suggest all of the features of claim 9 and 14. *Mathews* fails to remedy this deficiency.

Because *Santilli* in view of *Duff* and *Zucherman* and further in view of *Mathews* fails to teach or suggest all of the features of claims 9 and 14, *Santilli* in view of *Duff* and *Zucherman* and further in view of *Mathews* cannot render claims 9 and 14 obvious under 35 U.S.C. §103(a). Dependent claims have at least the features of the independent claims from which they depend. Therefore, *Santilli* in view of *Duff* and *Zucherman* and further in view of *Mathews* cannot render claims 10 and 11 (which depend from claim 9) and claims 15 and 16 (which depend from claim 14) obvious under 35 U.S.C. §103(a).

III. REJECTION UNDER 35 U.S.C. §103(A) OVER *SANTILLI* IN VIEW OF *DUFF* AND *ZUCHERMAN*

Claims 5, 17 and 19

The Examiner rejected claims 5, 17 and 19 under 35 U.S.C. §103(a) as being unpatentable over *Santilli* in view of *Duff* and *Zucherman*. Applicants respectfully traverse the rejection.

In the Office Action, the Examiner writes that “the combination...disclose the claimed invention except for the shape of the spacer being elliptical. It would have been an obvious matter of design choice.” See OA, page 4. For the reasons given above in Section I, *Santilli* in view of *Duff* and *Zucherman* fails to teach or suggest all of the features of claims 1 and 12.

Because *Santilli* in view of *Duff* and *Zucherman* fails to teach or suggest all of the features of claims 1 and 12, *Santilli* in view of *Duff* and *Zucherman* cannot render claims 1 and 12 obvious under 35 U.S.C. §103(a). Dependent claims have at least the features of the independent claims from which they depend. Therefore, *Santilli* in view of *Duff* and *Zucherman* cannot render claim 5 (which depends from claim 1) and claims 17 and 19 (which depend from claim 12) obvious under 35 U.S.C. §103(a).

IV. ALLOWABLE SUBJECT MATTER

Applicants appreciate the indication that claims 20-28 are allowed.

V. NEW CLAIMS

Applicants submit that newly added claims 50 and 51 are allowable over the cited prior art.

VI. CONCLUSION

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is

respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 03/01/2007

By: Michael L. Robbins/
Michael L. Robbins
Reg. No. 54,774



FLIESLER MEYER LLP
650 California Street, 14th Floor
San Francisco, California 94108
Telephone: (415) 362-3800